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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,494	07/05/2001	Tomihiko Azuma	14744	2580

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EXAMINER

SALL, EL HADJI MALICK

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/899,494

**Applicant(s)**

AZUMA, TOMIHIKO

**Examiner**

El Hadji M. Sall

**Art Unit**

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/18/04</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

***DETAILED ACTION***

1. This action is responsive to the correspondence filed on August 3, 2005. Claims 1-10 are pending. Claims 3 and 8 are amended. Claims 1-10 represent method of vicariously executing translation of electronic mails for users, and apparatus, system and medium therefor.

2. ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9 and 10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicant discloses a medium for carrying a computer readable and executable program for executing the translating step.

To overcome this type of 101 rejection the claim need to be amended to include only the physical computer media and not a transmission media or other intangible or non-functional media. For the specification at the bottom, carrier medium and transmission media would be not statutory but storage media would be statutory.

**3. Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Boucher et al. U.S. 5,884,246.

Boucher teaches the invention as claimed including system and method for transparent translation of electronically transmitted messages (see abstract).

As to claims 1 and 9, Boucher teaches a method of vicariously executing translation of electronic mails, comprising

Judging whether translation is required for an electronic mail based on at least one of sender data associated with the electronic mail and addressee data associated with the electronic mail (column 3, lines 50-62, Boucher discloses method is provided for conveying an electronic communication from a sender authoring the communication in a first language to a recipient understanding a second language wherein an original communication is prepared, a recipient address for the original communication is provided, and at least one translation parameter to be applied to the original communication is determined (i.e. it is inherent that “whether translation is required based on one of sender data associated with the electronic mail and addressee (recipient) is judged (or determined)” took place ); and

Submitting for translation a part or all of the contents of the electronic mail by an Internet connection provider when it is judged that translation is required (column 3, lines 63-65; and column 4, lines 5-7, Boucher discloses the translation parameter(s) are dispatched to a translation site designated by a translation address via the communications network; and the translation is carried out at the translation site).

As to claims 2 and 10, Boucher teaches the method as claimed in claim 1, wherein said judging step is performed on the basis of combination information of the mail address of the user and the mail address of a communication partner of the user which is predetermined by the user for translation, said translation judging step being antecedent to said electronic mail translating step (column 3, lines 28-31, Boucher discloses determining the type of translation which should be carried out (i.e. inherently, "judging step is antecedent to the electronic mail translating step").

As to claim 3, Boucher teaches a provider machine comprising:

Translation judging means configured to judge whether translation is required for a electronic mail based on at least one of sender data associated with the electronic mail and addressee data associated with the electronic mail (column 3, lines 50-62, Boucher discloses method is provided for conveying an electronic communication from a sender authoring the communication in a first language to a recipient understanding a second language wherein an original communication is prepared, a recipient address for the original communication is provided, and at least one translation parameter to be applied to the original communication is determined (i.e. it is inherent that "whether translation is required based on one of sender data associated with the electronic mail and addressee (recipient) is judged (or determined)" took place ); and

Electronic mail transmitting means for transmitting, when the translation judging module judges that translation is required, to the address of a communication partner of an electronic mail or a terminal device of a user, a translated electronic mail

containing a translation text obtained by translating through the provider a part or all of the contents of the electronic mail (column 3, lines 63-65; and column 4, lines 5-7, Boucher discloses the translation parameter(s) are dispatched to a translation site designated by a translation address via the communications network; and the translation is carried out at the translation site).

As to claim 4, Boucher teaches the provider machine as claimed in claim 3, further comprising:

Information storage means for storing at least combination information of the mail address of the user and the mail address of a communication partner of the user, which is predetermined by the user for translation (figure 3A, item 208)

Translation judging means for judging whether the user-sending or user-addressed electronic mail corresponds to the electronic mail which is predetermined by the user to be translated, on the basis of the electronic mail addresses of a transmission source and a transmission destination of a user-sending electronic mail or user-addressed electronic mail and the combination information of said information storage means (figure 2, item 104; figure 3A, item 210).

As to claim 5, Boucher teaches the provider machine as claimed in claim 3, further comprising:

Information storage means for storing combination information of the mail address of the user, the mail address of a communication partner, which is predetermined by the user to be translated, and a language for a translation destination (figure 3A, item 208);

Translating means for translating a part or all of the contents of an electronic mail sent from the user or addressed to the user in the language of the translation destination on the basis of the combination information of said information storage means (figure 2, item 104; figure 3A, item 210); and

Translated electronic mail creating means for creating a translated electronic mail containing a translated text translated by said translating means (figure 3A, item 214).

As to claim 6, Boucher teaches the provider machine as claimed in claim 4, further comprising:

another information storage means for storing combination information of the mail address of the user, the mail address of a communication partner which is predetermined by the user to be translated, and a language for a translation destination (figure 2E, item 108, inherently, the host has its "mail address" and the "mail address of the communication partner" stored in its memory, therefore it can be viewed as another "information storage means").

translating means for translating a part or all of the contents of an electronic mail sent from the user or addressed to the user in the language of the translation destination on the basis of the combination information of said another information storage means (figure 2, item 104; figure 3A, item 210); and  
translated electronic mail creating means for creating a translated electronic mail containing a translated text translated by said translating means (figure 3A, item 214).

As to claim 7, Boucher teaches a terminal device comprising at least translated electronic mail receiving means for receiving a translated electronic mail transmitted from said electronic mail transmitting means of said provider machine as claimed in claim 3 (figure 3A, item 212).

As to claim 8, Boucher teaches the system of claim 3 comprising:

A terminal device comprising at least translated electronic mail receiving module configured to receive a translated electronic mail transmitted from said electronic mail transmitting means of said provider machine (figure 3A, item 214).


**4. Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to El Hadji M Sall whose telephone number is 571-272-4010. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

El Hadji Sall  
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